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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 09/609,228  | 06/30/2000  | Luigi Forlai         | 07704.0006                | 2813             |
| 22852   | 7590        | 10/21/2005           | EXAMINER                  |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | SUBRAMANIAN, NARAYANSWAMY |                  |
|   |             |                      | ART UNIT                  | PAPER NUMBER     |
|   |             |                      | 3624                      |                  |

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/609,228

Applicant(s)

FORLAI, LUIGI

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,6,17 and 20-33 is/are pending in the application.
- 4a) Of the above claim(s) 17,20-25,28 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,6,26,27,29,30,32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

EA

**DETAILED ACTION**

1. This office action is in response to applicants' communication filed on August 8, 2005. Election of group 1B claims 26, 27, 29, and 30, in response to election/restriction, is acknowledged by the examiner. Claims 2, 6, 17 and 20-33 are pending in the application. Claims 2, 6, 26, 27, 29, 30, 32 and 33 have been examined. The rejections and response to arguments are stated below.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 6, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Tuck et al (US Patent 6,115,698).

With reference to claim 2, Odom teaches a method for using an electronic network system to facilitate a transaction between a seller and a buyer, said method comprising the steps of: inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service (See Odom Column 3 lines 20-26); randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an unexpected period of time (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); and withdrawing the display of the randomly generated sale offer in response to an absence of an indication of acceptance of the randomly generated sale offer by the buyer within a predetermined period of

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time after the step of displaying the randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67).

Posting information on the Web and sending e-mail to notify implies displaying at an unexpected period of time.

Odom does not explicitly teach the step where an offer price is substantially equal to a delivery price associated with the transaction.

Tuck teaches the step where an offer price is substantially equal to a delivery price associated with the transaction (See Tuck Column 9 lines 40-43).

Both Tuck and Odom are concerned with facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Tuck. The combination of disclosures suggests that buyers are benefited from knowing how much they are paying for the goods/services without any hidden delivery and S&H costs.

With reference to claim 6, Odom teaches a method of making a sale offer from a seller to at least one buyer visiting a Internet web site, comprising the steps of: displaying, on the web site, a sale offer to purchase a product or service to the at least one selected buyer at a random point in time unknown to the buyer (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); and withdrawing the displayed sale offer from the Internet website when the at least one buyer does not indicate acceptance of the sale offer within a predetermined period of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies displaying at a random point in time unknown to the buyer.

Odom does not explicitly teach the step where an offer price is substantially equal to a delivery price of the product or service.

Tuck teaches the step where an offer price is substantially equal to a delivery price associated with the transaction (See Tuck Column 9 lines 40-43).

Both Tuck and Odom are concerned with facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Tuck. The combination of disclosures suggests that buyers are benefited from knowing how much they are paying for the goods/services without any hidden delivery and S&H costs.

With reference to claim 27, Odom teaches the step wherein the step of randomly displaying includes displaying the at least one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer (See Odom Column 5 lines 34-38, seller intervention implies the ability of the seller to display one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer).

4. Claims 26, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Tuck et al (US Patent 6,115,698) and further in view of Smith (US Patent 6,502,076 B1)

With reference to claims 26, 29 and 30, Odom teaches methods of claim 2 and 6 as discussed above including the step of randomly displaying includes displaying the at least one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer (See Odom Column 5 lines 34-38, seller intervention implies the

ability of the seller to display one sale offer to the selected buyer over a predetermined period of time determined by the seller and unknown to the selected buyer).

Odom does not explicitly teach the step of providing a random frequency device for displaying the at least one sale offer in an unpredictable manner.

Smith teaches the step of providing a random frequency device for displaying the at least one sale offer in an unpredictable manner (See Smith Column 6 lines 46-54 and Column 17 lines 17-20).

Both Smith and Odom are concerned with the problem of providing information to buyers to facilitate selling of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Smith. The combination of disclosures suggests that sellers would have benefited from being able to target different buyers by randomly varying the times when products are offered.

5. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Tuck et al (US Patent 6,115,698) and further in view of Conklin et al (US Patent 6,141,653).

With reference to claim 32, Odom teaches a method of claim 2 as discussed above including a first indication of acceptance from the buyer in response to the random display of the at least one sale offer (See Column 6 lines 27-33), negotiation between the seller and the buyer (See Odom Column 6 lines 11-19) and clearing the transaction (Column 3 lines 43-46 and Column 7 lines 56-60) and requesting delivery of the offered product or service to the buyer (inherent in the disclosure of Odom).

Odom does not explicitly teach the steps of displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; and transferring a sum corresponding to the selected payment method from the buyer to the seller.

Conklin teaches the steps of iteratively negotiating multiple variables, documenting the transaction, providing payment options and transferring the payment amount online (See Conklin Column 14 lines 3-31 and lines 63-65). These steps are common in trading between two parties to a transaction. The disclosure of Conklin is interpreted to include the features of displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in

response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; and transferring a sum corresponding to the selected payment method from the buyer to the seller.

Both Conklin and Odom are concerned with the problem of facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Conklin. The combination of disclosures suggests that both parties to the transaction would have benefited from the smooth negotiations and conclusion of the transactions provided by the disclosures.

With reference to claim 33, Odom teaches a method for using an electronic network system to facilitate a transaction between a seller and a buyer said method comprising the steps of: inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service (See Odom Column 3 lines 20-26); randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an unexpected period of time (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); withdrawing the display of the randomly generated sale offer in response to an absence of an indication of acceptance of the randomly generated sale offer by the buyer within a predetermined period of time after the step of displaying the randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67, posting information on the Web and sending e-mail to notify implies displaying at an unexpected period of time); receiving, through the electronic network system, a first indication of acceptance from the buyer in response to the random display of the at least one sale offer (See Column 6 lines 27-33); and requesting delivery of the offered product or service to the buyer (inherent in the disclosure of



Odom), wherein the at least one term associated with the randomly generated sale offer comprises an offer price substantially equal to a delivery price associated with the sale offer transaction (See discussion of claim 2 above).

Odom does not explicitly teach displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; transferring a sum corresponding to the selected payment method from the buyer to the seller.

Conklin teaches the steps of iteratively negotiating multiple variables, documenting the transaction, providing payment options and transferring the payment amount online (See Conklin Column 14 lines 3-31 and lines 63-65). These steps are common in trading between two parties to a transaction. The disclosure of Conklin is interpreted to include the features of displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer; displaying an acceptance form to the buyer in response to the second

indication of acceptance from the buyer; receiving a third indication of acceptance from the buyer in response to the display of the acceptance form for forming a purchase agreement concerning the offered product or service; displaying at least one payment method option in response to the third indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; and transferring a sum corresponding to the selected payment method from the buyer to the seller.

Both Conklin and Odom are concerned with the problem of facilitating transaction between buyers and sellers of goods and services. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Odom to include the teachings of Conklin. The combination of disclosures suggests that both parties to the transaction would have benefited from the smooth negotiations and conclusion of the transactions provided by the disclosures.

#### ***Response to Arguments***

6. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

#### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Tavor et al (US Patent 6,553,347 B1) (April 22, 2003) Automatic Virtual Negotiations

(b) Meyer et al (US Patent 6,915,271 B1) (July 5, 2005) Method and System for Delivering Redeeming Dynamically and Adaptively Characterized Promotional Incentives on a Computer Network


(c) Van Luchene (US Patent 6,223,163 B1) (April 24, 2001) Method and Apparatus for Controlling Offers that are Provided at Point-of-sale Terminal

(d) Wilkinson (US Patent 4,571,546) (February 18, 1986) Digital Random Error Generator Supplying Burst Error Signals of Random Durations Starting at Random Times

(e) Conklin et al (US Patent 6,338,050 B1) (January 8, 2002) System and Method for Providing and Updating User Supplied Context for a Negotiating System

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dr. N. Subramanian  
October 16, 2005